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Applicant : GIEFER et al.
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Examiner : Phillip A. Johnson
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Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

APPEAL BRIEF

(1) REAL PARTY IN INTEREST.

The real party in interest is ZF Friedrichshafen AG.

(2) RELATED APPEALS AND INTERFERENCES.

There are believed to be no related appeals and interferences.

(3) STATUS OF CLAIMS.

Claims 1-15 and 17-21 are on appeal.

Claim 16 has been canceled.

Claims 1-8 and 11-14 have been rejected under 35 U.S.C. 103(a) as being unpatentable

over Murakami (US 5,706,701) in view of Kim (US 4,558,609).

Claim 9 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim and in further view of Tucker (US 7,032,074).

Claim 10 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim and in further view of Nedachi (US 5,588,329).

Claim 15 and 17-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim.

Claim 21 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim.

(4) STATUS OF AMENDMENTS.

An After Final Amendment in response to the final Office Action of November 12, 2009 has not been filed by Appellant.

(5) SUMMARY OF THE CLAIMED SUBJECT MATTER

CLAIM 1:

The present invention is directed to a shifting device for transmitting shift commands to a motor vehicle transmission (page 1, lines 8-9). Conventional shifting devices have a switch already integrated in the hand knob so that an electrical connection must be made at the selector level and inserted into the hand knob with a plug. Appellant has discovered that

complicated and expensive special safety precautions are needed to protect this switch and related plug-in connection during the transport of the conventional shifting device to the motor vehicle manufacturer. Appellant has solved this problem by providing an adapter 7 with an integrated switch 5a (hereinafter "switch adapter" (page 5, lines 14-15; Figures 1-3) with an outer surface that defines a recess 8a (page 9, lines 5-6; Figures 1-3) wherein one or more electrical lines 6 extend within the recess 8a (page 9, lines 5-6). The arrangement of the one or more lines 6 in the recess 8a in the switch adapter 7 advantageously does not require the complicated safety measures for the switch and for the one or more lines as featured in conventional techniques. This significantly reduces the overall manufacturing costs of shifting device. The arrangement of the one or more lines in the recess in the adapter 7 saves a significant amount of manufacturing costs since an electrical connection does not have to be made at the selector when the shifting device arrives at the vehicle manufacturer.

The shifting device comprises a housing support structure 2 (page 10, lines 1-2; Figures 3 and 4) and a selector lever 4 for transmitting shift commands to the motor vehicle transmission (page 9, lines 14-15; Figures 1 - 4). The selector lever 4 has an upper portion (Figures 1 - 4). The shifting device includes a hand knob 3 that forms a gripping surface for engagement by a hand of a driver of the motor vehicle (page 9, lines 6-8; Figure 3 and Figure 4). The shifting device also includes a connection cable (page 5, line 9; Figures 1-3) that comprises one or more lines 6 for transmitting electrical and/or optical signals (page 9, lines 5-6). The shifting device comprises a switch 5a (page 9, lines 11-13; Figures 1 - 4). The switch adapter 7 is mounted on the upper portion of the selector lever 4 (Figures 1 - 4). The

switch 5a is integrated with the switch adapter 7 (page 10, lines 3-5; Figure 1 - 4). The switch adapter 7 has an outer surface that defines the recess 8a (Figures 1-3). At least a portion of the one or more lines 6 extends within the recess 8a (page 9, lines 5-6; Figures 1-3). The switch adapter 7 defines a connection between the selector lever 4 and the hand knob 3 (page 3, lines 13-17; Figures 1-3). The shifting device is provided for installation in a motor vehicle (page 4, lines 1-3). A shifting gate 26 is pushed over the selector lever 4 (page 4, lines 13-14; Figure 1 as filed with Amendment of May 7, 2009). The switch adapter 7 is located at a position above the shift gate 26 (Figure 1 as filed with Amendment of May 7, 2009). The hand knob 3 is connected to upper portion of selector lever 4 via the switch adapter 7 (Figure 3 and Figure 4).

CLAIM 2:

The switch 5a integrated in the adapter 7 (switch adapter) may include means for transmitting electrical and/or optical signals (35 U.S.C. 112, sixth paragraph; page 5, lines 4-5; page 5, lines 9-12).

CLAIM 3:

The switch adapter 7 of claim 1 may have a switch interface for a connection cable (page 5, line 9).

CLAIM 4:

The portion of the one or more lines 6 of claim 1 may be located adjacent to the exterior surface of the switch adapter 7 (Figures 1-3). The hand knob 3 may surround the switch adapter 7 (page 11, lines 3-4; Figure 4). The switch adapter 7 may have a top outer surface (Figures 1-3). The top outer surface defines a switch recess (Figures 1-3). The switch 5a may be located in the switch recess (Figures 1-3). The switch adapter 7 and the hand knob 3 may be located at a spaced location from the shift gate 26 (page 11, lines 4-6; Figure 1 as filed with Amendment of May 7, 2009). The shift gate 26 may be located at a position below the hand knob 3 (Figure 1 as filed with Amendment of May 7, 2009).

CLAIM 5:

The switch adapter 7 of claim 1 may have a switch display part 5 (page 9, lines 11-13; Figures 2-4).

CLAIM 6:

The shifting device of claim 4 may further comprise a switch display part 5 (page 9, lines 11-13; Figures 2-4). The switch display part 5 may be arranged opposite the switch 5a (Figures 2 and 3).

CLAIM 7

The switch adapter 7 of claim 1 may have at least one guide element 9 for positioning

the hand knob 3 (page 8, lines 14-15; Figures 1-3).

CLAIM 8:

The switch adapter 7 of claim 1 may have a boring, into which the selector lever 4 can be at least partially inserted (page 6, lines 15-16).

CLAIM 9:

The switch adapter 7 of claim 1 may be fastened to the selector lever 4 via a screw connection (page 7, lines 1-3).

CLAIM 10:

The switch adapter 7 of claim 1 may be fastened to the selector lever 7 via a clip connection (page 7, lines 4-6).

CLAIM 11:

The switch adapter 7 of claim 1 may have a plastic molding, which is injection-molded on the selector lever via an injection molding process (page 7, lines 7-9).

CLAIM 12:

The switch adapter 7 of claim 1 may have an actuator button part connected to the switch 5a (page 5, line 17 through page 6, line 1; page 9, lines 12-13).

CLAIM 13:

The hand knob 3 of claim 12 may have an opening 3a for access to the actuator button part (page 11, lines 4-6; Figure 4).

CLAIM 14:

The actuator button part of claim 13 may also comprise a switch display part 5 (page 9, lines 11-12; Figures 2 - 4).

CLAIM 15:

Claim 15 is directed to a shifting device for transmitting shift commands to a motor vehicle transmission (page 1, lines 8-9; Figures 1 - 4). A critical feature of the present invention is that the adapter 7 has an integrated switch 5a (hereinafter “switch adapter”). The switch adapter 7 has an outer side surface that defines a recess 8a (page 5, lines 14-15; page 9, lines 5-6; Figures 1-3) wherein a connection cable is located within the recess 8a (page 5, line 9; Figures 1-3). This advantageously provides particular electrical connection protection features that prevent the connection cable from being damaged during transportation to a motor vehicle manufacturer. This significantly reduces the manufacturing costs of the shifting device as no complicated packaging is required to protect the electrical connection during shipment.

The shifting device comprises a support structure 2 (page 10, lines 1-2; Figures 3 and 4) and a selector lever 4 (page 9, lines 14-15; Figures 1 - 4). The selector lever 4 comprises an upper selector lever portion and a lower selector lever portion (Figure 1 - 4). The lower

selector lever portion is connected to the support structure 2 (Figure 4). The selector lever 4 transmits shift commands to the motor vehicle transmission (page 3, lines 10-13). The shifting device includes the connection cable (page 5, line 9; Figures 1-3) and the switch adapter 7 (page 5, lines 14-15; Figures 1-3). The switch adapter 7 is mounted to the upper selector lever portion of the selector lever 4 (Figures 1-3). The switch adapter 7 has the integrated switch 5a (page 9, lines 11-13; Figures 1 - 4). The integrated switch 5a includes a switch interface 10 (page 9, lines 4-5) for the connection cable and a means for transmitting electrical and/or optical signals (35 U.S.C. 112, sixth paragraph; page 5, lines 4-5; page 5, lines 9-12). The switch adapter 7 has an adapter outer side surface (Figures 1-3). The adapter outer side surface defines a recess 8a (page 9, lines 5-6; Figures 1-3). The connection cable is located within the recess 8a (page 9, lines 5-6; Figures 1-3). The connection cable is located adjacent to the outer surface of the adapter 7 (Figures 1-3). The shifting device includes a hand knob 3 that forms a gripping surface for engagement by a hand of a driver of the motor vehicle driver (page 9, lines 6-8; Figure 3 and Figure 4). The switch adapter 7 defines a connection between the upper selector lever portion of the selector lever 4 and the hand knob 3 (page 3, lines 13-17; Figures 1-3). The switch adapter 7 is connected to the hand knob 3 (Figures 1-3). The shifting device is provided for installation in a motor vehicle (page 4, lines 1-3). The diameter of the selector lever 4 and the switch adapter 7 is smaller than a shift gap defined by side edges of a shift gate 26 whereby the shift gate 26 is passed over the selector lever 4 and the switch adapter 7 (page 10, lines 10-16; Figure 1). The switch adapter 7 is located at a position above the shift gate 26 (Figure 1 as filed with Amendment of May 7, 2009).

CLAIM 17:

The connection cable of claim 15 may have a line 6 (page 9, lines 4-5). The line 6 may transmit the electrical and/or optical signals from the transmitting means to the support structure 2 (page 9, lines 5-6).

CLAIM 18:

The switch adapter 7 of claim 15 may have at least one guide element 9 for positioning the hand knob 3 (page 8, line 15 through page 9, line 2).

CLAIM 19:

The switch adapter 7 of claim 15 may have a part with at least one of an actuator button part and a switch display part connected to the switch 5a (page 5, line 17 through page 6, line 1; page 9, lines 11-13; Figures 2 - 4). The switch adapter 7 may have a top outer surface (Figures 1-3). The top outer surface may define an integrated switch recess (Figures 1-3). The integrated switch 5a may be arranged in the integrated switch recess (Figures 1-3). The hand knob 3 may surround the switch adapter 7 (page 11, lines 3-4; Figure 4).

CLAIM 20

The hand knob 3 of claim 19 may have an opening for access to the at least one of an actuator button part and a switch display part connected to the switch 5a (page 11, lines 4-6; Figure 4). The switch display part may be disposed opposite the integrated switch (Figure 3).

CLAIM 21:

Claim 21 is directed to a shifting device that has a shift gate 26 that is located below an adapter 7 with an integrated switch 5a (hereinafter “switch adapter”) wherein the switch adapter 7 has a recess 8a with one or more lines 6 located within the recess 8a (Figure 1 as filed with Amendment of May 7, 2009). The arrangement of the switch adapter 7 above the shift gate 26 advantageously allows for a simple electrical connection of the switch adapter 7 to the support structure 2 (Figure 4). Further, the arrangement of the one or more lines 6 saves significant packaging costs since complicated packaging is not necessary to protect the one or more lines 6 from becoming damaged.

The shifting device comprises the support structure 2 (page 10, lines 1-2; Figures 3 and 4) and a selector lever 4 (page 9, lines 14-15; Figures 1 - 4). The selector lever 4 has an upper end and a lower end (Figures 1 - 4). The lower end is connected to the support structure 2 (Figure 4). The selector lever 4 transmits shift commands to the motor vehicle transmission (page 3, lines 10-13). The shifting device includes a connection cable having one or more lines 6 (page 5, line 9; Figures 1-3; page 9, lines 5-6). The switch adapter 7 is mounted to the upper end of the selector lever 4 (Figures 1 - 4). The switch adapter has a top outer surface (Figures 1-3). The top outer surface defines an integrated switch recess (Figures 1-3). The switch adapter 7 has the integrated switch 5a arranged in the integrated switch recess (Figures 1-3). The integrated switch 5a includes a switch interface 10 (page 9, lines 4-5). The switch adapter 7 has an adapter outer side surface (Figures 1-3). The adapter outer side surface defines a recess. One or more lines are located within said recess 8a (page 9, lines 5-6; Figures 1-3).

The one or more lines 6 are located adjacent to the adapter outer side surface (Figures 1-3). The one or more lines are connected to the switch interface 10 (Figure 1). The shifting device includes a hand knob 3 that forms a gripping surface for engagement by a hand of a driver of the motor vehicle driver (page 9, lines 6-8; Figure 3 and Figure 4). The hand knob 3 surrounds the switch adapter 7 (page 11, lines 3-4; Figure 4). The switch adapter 7 defines a connection between the upper end of the selector lever 4 and the hand knob 3 (page 3, lines 13-17; Figures 1-3). The hand knob 3 is connected to the upper end of the selector lever 4 via the switch adapter 7 (Figures 1-3). The shifting device is provided for installation in a motor vehicle (page 4, lines 1-3). The diameter of the selector lever 4 and the switch adapter 7 is smaller than a shift gap defined by side edges of a shift gate 26 (page 10, lines 10-16; Figure 1). The shift gate 26 is passed over the selector lever 4 and the switch adapter 7 (page 10, lines 10-16; Figure 1). The hand knob 3 is arranged on the switch adapter 7 (Figures 1-3). The shift gate 26 is located at a position below the switch adapter 7 (Figure 1 as filed with Amendment of May 7, 2009).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.

Whether claims 1-8 and 11-14 are rejectable under 35 U.S.C. 103(a) as being unpatentable over Murakami (US 5,706,701) in view of Kim (US 4,558,609).

Whether claim 9 is rejectable under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim and in further view of Tucker (US 7,032,074).

Whether claim 10 is rejectable under 35 U.S.C. 103(a) as being unpatentable over

Murakami in view of Kim and in further view of Nedachi (US 5,588,329).

Whether claims 15 and 17-20 are rejectable under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim.

Whether claim 21 is rejectable under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim.

(7) ARGUMENT.

ISSUE: Whether claims 1-8 and 11-14 are rejectable under 35 U.S.C. 103(a) as being unpatentable over Murakami (US 5,706,701) in view of Kim (US 4,558,609).

CLAIM 1

The invention is a shifting device for transmitting shift commands to a motor vehicle transmission. The inventors noted the problem that conventional shifting devices are difficult to connect electrically to a housing structure. Further, conventional shifting devices require complicated electrical connections that are difficult to connect to the housing structure once the shifting device is delivered to the motor vehicle manufacturer. The delivery procedure can damage the electrical switch connection structure. The inventors of the present invention have solved this problem by providing an adapter mounted on an upper portion of a selector lever wherein the adapter has an integrated switch (hereinafter "switch adapter"). A critical feature of the present invention is that at least a portion of a cable, which includes one or more lines for transmitting electrical and/or optical signals, extends within a recess defined by an outer

surface of the switch adapter. This allows the electrical and/or optical connection of the switch adapter to be protected while the adapter is transported to the motor vehicle manufacturer. These particular electrical and/or optical connection features saves significantly on manufacturing costs since complicated packaging is not necessary to protect the connection. The switch adapter and the portion of the cable extending in the recess are located at a position above the shift gate. This advantageously allows the switch adapter to be quickly and easily connected to the housing structure without any switch connections having to be inserted. This saves significantly on manufacturing costs since less time and labor is needed to connect the switch adapter to the housing structure.

Murakami discloses a wiring-harness connection structure of a transmission shift-lever device. The wiring-harness connection structure includes a skeleton frame 9 that is integrally formed with a pair of conducting-line guides 9c at the lower end of its cylindrical hollow section. Each conducting-line guide 9c has a guide hole 9d and an essentially cylindrical hollow portion 7, both intercommunicating with each other. The lower end of the conductor 6 is inserted into the guide hole 9d and partially exposed into the hollow portion 7. The lower opening end of the cylindrical hollow section of the skeleton frame 9 is square. The square is constructed by four sides 9e of a greater curvature and four corners 9f of a smaller curvature, each corner 9f interconnecting the two adjacent side 9e. A shift knob 1 is fitted onto an upper end of a shift lever 24 through an elongated shift slot 26 formed on a position-indicator cover assembly 25 and an opening 23.

Although Murakami is related to a shift device, Murakami takes a completely different

approach than that of the present invention. Murakami fails to teach or suggest a switch adapter as featured in the present invention. Murakami discloses an overdrive control switch (OD switch) 3. However, the OD switch 3 of Murakami is provided on one side of the shift knob 1 and is not integrated with the skeleton frame 3 as claimed. This does not provide a switch adapter as featured in the present invention. Compared with Murakami, the switch adapter of the present invention includes the adapter 7 and the switch 5a integrated therewith. In contrast to the present invention, Murakami takes a very different approach by disclosing a skeleton frame 9 in which the OD switch 3 is not integrated with the skeleton frame 9. Murakami discloses that the OD switch 3 is merely provided on one side of the shift knob 1, but does not provide any teaching or suggestion that would direct a person of ordinary skill in the art toward integrating the OD switch 3 with the skeleton frame 9 as claimed.

Murakami fails to teach and fails to suggest the combination of a switch adapter located at a position above a shift gate wherein the outer surface of the switch adapter defines a recess which receives at least a portion of a cable as claimed. The final rejection takes the position that the skeleton frame 9 of Murakami is the equivalent of the switch adapter of the present invention. Appellant respectfully disagrees with this interpretation as the skeleton frame 9 of Murakami does not include a switch integrated therewith and the skeleton frame 9 does not have an outer surface that defines a groove for receiving a cable as claimed. Even assuming the skeleton frame 9 of Murakami is the equivalent of the switch adapter of the present invention (which Appellant maintains it is not), the skeleton frame 9 includes guide holes 9d that are located below the shift slot 26. This is clearly shown in Figures 1, 5A and 6. This

disadvantageously does not allow for a simple and quick electrical and/or optical connection of the conducting lines to the position-indicator cover assembly 25 as featured in the present invention.

The final rejection takes the position it would be an obvious matter of design choice to provide the skeleton frame 9 of Murakami at a position above the shift slot 26 as featured in the present invention. However, there must be some teaching or suggestion to support the position that the features claimed are obvious. No such teaching or suggestion exists in Murakami for the skeleton frame 9 having an integrated switch to form a switch adapter structure wherein the switch adapter structure is mounted to an upper portion of a selector lever at a position above the shift slot 26 as claimed. The skeleton frame 9 cannot be considered the equivalent of the switch adapter of the present invention as the OD switch 3 is not integrated with the skeleton frame 9 and the skeleton frame 9 does not have a recess defined by an outer surface thereof as claimed. Compared with Murakami, the switch adapter is located at a spaced location from the shift gate such that the switch adapter is located at a position above the shift gate. This provides particular connection advantages such that the switch adapter can be quickly and easily connected to the housing structure. Further, the recess defined in the outer surface of the switch adapter advantageously protects the cable during shipment of the adapter to the motor vehicle manufacturer. There is certainly no teaching or suggestion in Murakami for a switch adapter having a recess wherein the switch adapter is located at a position above a shift gate as claimed. Murakami clearly takes a different approach as the skeleton frame 9 does not have an integrated switch and does not have an outer surface that

defines a recess as claimed. As such, there is no direction for the person of ordinary skill the art with regard to a switch adapter that is located above a shift gate as the skeleton frame 9 of Murakami does include the features of the switch adapter as claimed. Accordingly, the prior art as a whole does not establish a *prima facie* case of obviousness as the prior art as a whole does not teach or suggest critical aspects of the present invention.

Kim discloses a joystick controller 10 having a two-part housing 11, which includes a cover 20 and a bottom 30. Mounted on the cover 20 is a handle assembly 40, which includes an elongated, cylindrical, tubular shaft 41 that extends through an aperture 24. The tubular shaft 41 has an axial bore 47 therethrough having an enlarged diameter upper end portion 48 defining a cylindrical recess. Extending axially through the bore 47 is an elongated rod 50. Disposed in surrounding relationship with the rod 50 and seated in the enlarged-diameter upper end portion 48 of the bore 47 is a helical compression spring 54 which bears against the push button 53 and resiliently urges the rod 50 axially upwardly to a normal rest position.

A person of ordinary skill in the art would not be directed to the teachings of Kim as Kim is not related to the field of motor vehicle shifting devices. Kim fails to appreciate the problems with mounting a shifting device in a motor vehicle since Kim only deals with the problem of mounting different handle assemblies on a joystick. The prior art references as a whole do not provide any suggestion of using the teachings of Kim to modify the device of Murakami. Kim deals with a completely different technical field than that of Murakami. Instead of being concerned with providing a wiring-harness connection structure of a transmission shift-lever device for a motor vehicle as featured in Murakami, Kim is concerned

with providing a joystick that has a handle member that can be removed so that a different handle assembly can be attached. Kim is not related to the field of motor vehicle transmission shifting devices.

Although Kim is not related to the field of transmission shifting devices, there are some similarities between the joystick of Kim and shifting devices. Kim does disclose a pivot lever 41 with an actuator button 53 that is connected to a rod 50 that actuates a leaf switch 52. The final rejection takes the position that the actuator button 53 is the equivalent of the switch of the present invention and the pivot lever 41 is the equivalent of the switch adapter of the present invention. This is an unfair interpretation of the Kim reference. The actuator button 53 cannot be considered a switch since the actuator button does not have any electrical connection. Kim clearly discloses that the actuator button 53 engages a switch 52. The switch 52 of Kim is not integrated with the pivot lever 41. As such, the pivot lever 41 cannot be the equivalent of the switch adapter of the present invention. Even assuming that the pivot lever 41 is somehow the equivalent of the switch adapter of the present invention (which Appellant maintains it is not since the switch 52 is not integrated with the pivot lever 41), the switch 52 is located within a two-part housing, which is similar to a shift gate, as clearly shown in Figure 2. Kim does not teach or suggest the combination of a switch adapter that is located at a position above a shift gate as claimed. There is simply no teaching or suggestion in the disclosure of Kim for providing a switch adapter at a position above the two-part housing, which is similar to a position above the shift gate, as claimed. In fact, Kim does not provide any teaching or suggestion that an outer surface of the pivot lever 41 defines a recess for

receiving at a least a portion of a cable. As clearly shown in Figure 2, there is no recess defined in the pivot lever 41 that receives a cable having one or more lines as claimed. In the present situation, the prior art reference relied on does not teach the structural features claimed and does not provide any teachings or suggestions with regard to the desirability or need to provide the structural features claimed. As such, the prior art as a whole does not establish a *prima facie* case of obviousness as the prior art as a whole does not direct a person of ordinary skill in the art toward critical features of the present invention.

It is requested that the rejection of claim 1 be reversed.

CLAIM 2

Claim 2 presents the subject matter of claim 1 but requires that the switch adapter includes a means for transmitting electrical and/or optical signals. The references fail to teach or suggest a switch adapter that is located at a position above a shift gate and clearly fails to suggest or teach this where the switch adapter includes a means for electrical and/or optical signal transmission. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 2.

CLAIM 3

Neither Murakami nor Kim teach or suggest a switch adapter having an outer surface that defines a recess with at least a portion of a cable extending therethrough wherein the switch adapter is located at a position above a shift gate as claimed. At most, Murakami and

Kim direct a person of ordinary skill in the art toward a skeleton frame or a tubular shaft that does not have an integrated switch. Further, Kim directs a person of ordinary skill in the art toward a switch 52 that is provided below a two-part housing. However, none of the cited prior art references direct a person of ordinary skill in the art toward providing a switch adapter above a shift gate as featured in the present invention. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 3.

CLAIM 4

Murakami and Kim fail to teach or suggest a hand knob that surrounds a switch adapter with the switch adapter having an outer surface that defines a recess wherein the hand knob and the switch adapter are located at a spaced location from the shift gate. According to the present invention, the shift gate is located below the hand knob and the switch adapter. Murakami merely discloses a shift knob 1 and a skeleton frame 9 that pass through a shift slot 26. The skeleton frame 9 of Murakami is not a switch adapter as claimed since the skeleton frame 9 does not have an integrated switch therewith. Even assuming the skeleton frame 9 is somehow the equivalent of the switch adapter of the present invention (which Appellant maintains it is not), neither the shift knob 1 nor the skeleton frame 9 is located at a spaced location from the shift slot 26 such that the shift slot 26 is located at a position below the shift knob 1 and the skeleton frame 9 as claimed. Kim also fails to provide any teaching or suggestion for a switch adapter and a hand knob that are located at a position above a shift gate as claimed. A person of ordinary skill in the art would not be directed to the teachings of Kim in view of the

disclosure of Murakami since Kim fails to be concerned with providing a shifting device in a motor vehicle as featured in Murakami. Kim is merely concerned with the problem of providing interchangeable handle assemblies for a joystick. Even if a person of ordinary skill in the art were to be directed to the teachings of Kim, Kim does not teach or suggest a switch adapter that is located above a shift gate as claimed. Kim clearly discloses that the pivot lever 41 is not integrated with the switch 52 and that the pivot lever 52 passes through the two-part housing such that the two-part housing is not located at a position below the pivot lever 41 as featured in the present invention. As such, the prior art as a whole takes a completely different approach and fails to establish a *prima facie* case of obviousness. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 4.

CLAIM 5

The final rejection takes the position that the top surface of push button 53 of Kim has a switch display part. The push button 53 is not a switch as claimed as the push button 53 does not have any electrical features. Even assuming that the push button 53 could somehow be the equivalent of a switch (which Appellant maintains it is not), there is no teaching or suggestion of the push button 53 of Kim having any type of display part as claimed. Compared with Kim, the switch adapter of the present invention has a switch display part. This allows the display part to visually indicate to a driver the particular state of the transmission, such as whether the transmission is in drive or neutral. In contrast to the present invention, Kim only discloses a push button 53, but does not teach or suggest that a switch display part is provided on the top

of the push button 53. As such, the prior art as a whole does not establish a *prima facie* case of obviousness as the prior art as a whole does not teach or suggest each and every feature of the claimed combination. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 5.

CLAIM 6

The push button 53 of Kim is not a switch as featured in the present invention. The push button 53 has no electrical features as claimed. The final rejection takes the position that the top surface of push button 53 of Kim is the equivalent of the switch display part of the present invention. However, a fair reading of the Kim reference discloses that there is no switch display part as featured in the present invention. Kim only teaches a push button 53, but there is no teaching or suggestion of the push button 53 of Kim having any type of display part as claimed. In fact, there is no teaching or suggestion in Kim for a switch display part that is located opposite the push button 53 as claimed. Compared with Kim, the switch adapter of the present invention has a switch display part that is located opposite the switch. This allows the display part to visually indicate to a driver the particular state of the transmission, such as whether the transmission is in drive or neutral. In contrast to the present invention, Kim only discloses a push button 53, but does not teach or suggest that a switch display part is located opposite the push button 53 as featured in the present invention. As such, the prior art as a whole does not establish a *prima facie* case of obviousness as the prior art as a whole does not teach or suggest each and every feature of the claimed combination. Accordingly, it is

requested that the Examiner's rejection be reversed with respect to claim 6.

CLAIM 7

Claim 7 presents the subject matter of claim 1 but further provides that the switch adapter has at least one guide element for positioning the hand knob. The final rejection takes the position that the vertical rib portions disposed between guides 9c in Figure 6 of Murakami are the equivalent of the at least one guide element of the present invention. However, Murakami does not provide any teaching or suggestion that the vertical rib portions disposed between guides 9c are used for positioning the shift knob 1 as claimed. As such, the prior art as a whole does not establish a *prima facie* case of obviousness as the prior art as a whole does not teach or suggest each and every feature of the claimed combination. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 7.

CLAIM 8

Claim 8 presents the subject matter of claim 1 but requires that the switch adapter has a boring in which the selector lever is at least partially inserted. The references fail to teach or suggest a switch adapter that is located at a position above a shift gate and clearly fails to suggest or teach this where the switch adapter is mounted to an upper portion of the selector lever such that the switch adapter is located at a position above the shift gate. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 8.

CLAIM 11

Neither Murakami nor Kim teach or suggest a switch adapter having an outer surface that has a recess with at least a portion of a cable extending therethrough wherein the adapter is located at a position above a shift gate as claimed. At most, Murakami and Kim direct a person of ordinary skill in the art toward a skeleton frame or a pivot lever that do not have an integrated switch as claimed. This does not provide a switch adapter as claimed. Further, none of the cited prior art references direct a person of ordinary skill in the art toward providing the skeleton frame or pivot lever above a shift gate as featured in the present invention. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 11.

CLAIM 12

Claim 12 presents the subject matter of claim 1 but requires that the switch adapter has an actuator button connected to the switch. The references fail to teach or suggest a switch adapter that is located at a position above a shift gate and clearly fails to suggest or teach this where the switch adapter has an actuator button connected to a switch. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 12.

CLAIM 13

Neither Murakami nor Kim teach or suggest a switch adapter having an outer surface wherein the switch adapter is connected to an upper portion of a selector lever such that the switch adapter is located at a position above a shift gate as claimed. At most, Murakami

discloses a skeleton frame 9 that is located at a position below a shift slot 26. The skeleton frame 9 of Murakami is not the equivalent of the switch adapter of the present invention since the skeleton frame 9 does not have an integrated switch as claimed. Even assuming that the skeleton frame 9 of Murakami is the equivalent of the switch adapter of the present invention (which Appellant maintains it is not), there is no teaching and no suggestion in Murakami or Kim that would direct a person of ordinary skill in the art toward providing the skeleton frame 9 at a position above the shift slot 26. Kim only directs a person of ordinary skill in the art toward a pivot lever passes through a two-part housing. However, Kim does not provide any teaching or suggestion for the pivot lever having an integrated switch as claimed. As such, the prior art as a whole does not establish a *prima facie* case of obviousness. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 13.

CLAIM 14

The prior art as a whole fails to teach or suggest an actuator button part that includes a switch display part as claimed. The final rejection takes the position that the top surface of push button 53 of Kim is the equivalent of the switch display part of the present invention. However, a fair reading of the Kim reference discloses that there is no switch display part as featured in the present invention. Kim only teaches a push button 53, but there is no teaching or suggestion of the push button 53 of Kim having any type of display part as claimed. In fact, there is no teaching or suggestion in Kim for a switch display part that is located opposite the push button 53 as claimed. Compared with Kim, the adapter of the present invention has a

switch display part that is located opposite the switch. This allows the display part to visually indicate to a driver the particular state of the transmission, such as whether the transmission is in drive or neutral. In contrast to the present invention, Kim only discloses a push button 53, but does not teach or suggest that a switch display part is located opposite the push button 53 as featured in the present invention. As such, the prior art as a whole does not establish a *prima facie* case of obviousness as the prior art as a whole does not teach or suggest each and every feature of the claimed combination. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 14.

Conclusion

The invention as claimed presents a combination of features which is neither taught nor suggested by the prior art. The rejection does not present a *prima facie* case of obviousness. The claimed invention should be considered patentable and nonobvious. Accordingly, it is requested that the rejections of the claims 1-8 and 11 - 14 based on prior art be reversed.

ISSUE: Whether claim 9 is rejectable under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim and in further view of Tucker (US 7,032,074).

Claim 9 should be considered patentable for the same reasons as discussed above with regard to claim 1. Claim 9 presents the combination of features claimed in claim 1, but further specifies that the switch adapter is fastened to the selector lever via a screw connection. This claim should further be considered patentable based on the further limitation in that a person

of ordinary skill in the art would not be directed to combine the teachings of Tucker in view of the Murakami reference and the Kim reference. Instead of being concerned with providing a wiring harness for a shift knob 1 as featured in Murakami, Tucker is concerned with the problem of connecting a two-stage, bi-directional shift lever vibration isolator. As already discussed above with respect to claim 1, Murakami and Kim do not provide any teaching or suggestion for a switch adapter that is connected to a selector lever wherein the switch adapter is located at a position above a shift gate as featured in the present invention. Tucker also does not teach or suggest connecting a switch adapter, which is located above a shift gate, to an upper portion of a selector lever wherein the switch adapter has an outer surface that defines a recess for receiving at least a portion of a cable as claimed. Accordingly, the subject matter of claim 9 represents a further departure from the teachings of the prior art. The subject matter of claim 9 is unobvious. The rejection of claim 9 does not present a *prima facie* case of obviousness. The claimed subject matter should be considered patentable over the prior art as a whole.

Conclusion

The prior art does not teach and does not suggest the combination of features claimed. The prior art directs the person of ordinary skill in the art toward structures which are dissimilar to the claimed structure. Each of the references teach in a direction away from the combination claimed. The references do not render the claimed subject matter obvious. Accordingly, it is requested that the rejection be reversed and that claim 9 be indicated to

patentably define over the prior art.

ISSUE: Whether claim 10 is rejectable under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim and in further view of Nedachi (US 5,588,329).

Murakami and Kim fail to teach and fail to suggest several aspects of the invention. Murakami and Kim do not render obvious the combination of features as the references fail to suggest the crux of the invention and fail to direct the person of ordinary skill in the art toward the combination claimed. The Nedachi reference also fails to suggest the invention. The references including Nedachi do not render obvious the combination including a switch adapter that is mounted to an upper portion of a selector lever such that the adapter is located at a position above a shift gate wherein the switch adapter has a recess with at least a portion of a cable extending through the cable. The prior art lacks the essential teaching of a switch adapter that is located above a shift gate. The references do not establish a *prima facie* case of obviousness.

Conclusion

The prior art does not teach and does not suggest the combination of features claimed. The prior art directs the person of ordinary skill in the art toward structures which are dissimilar to the claimed structure. Each of the references teach in a direction away from the combination claimed. The references do not render the claimed subject matter obvious. Accordingly, it is requested that the rejection be reversed and that claim 10 be indicated to

patentably define over the prior art.

ISSUE: Whether claims 15 and 17-20 are rejectable under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim.

CLAIM 15

The present invention relates to a shifting device for transmitting shift commands to a motor vehicle transmission. Applicant has discovered the problem that conventional shifting devices having an integrated switch in the hand knob require complicated and expensive safety precautions. Applicant has solved this problem by providing a shifting device which includes an adapter with an integrated switch (hereinafter "switch adapter"). The switch adapter is connected to an upper portion of a selector lever with the switch adapter being located a position above the shift gate. The switch adapter has an outer side surface that defines a recess wherein the connection cable is located within the recess. A hand knob is connected to the switch adapter. The arrangement of the connection cable in the recess of the switch adapter is an important feature of the present invention because it advantageously does not require the complicated safety measures for the switch and the connection cable as featured in conventional techniques. The arrangement of the connection cable in the recess in the switch adapter saves a significant amount of manufacturing costs since an electrical connection does not have to be made at the selector when the shifting device arrives at the vehicle manufacturer. The prior art as a whole fails to disclose such features or such manufacturing

cost savings advantages.

Murakami discloses a wiring-harness connection structure of a transmission shift-lever device. The device includes a shift knob 1 that is firmly fitted onto an upper end of a pipe-like shift lever 24 through an elongated shift slot 26 formed on a position-indicator cover assembly 25 and an opening 23 of a longitudinally elongated slide plate 22. A pair of rod-like signal lines 6 are connected to respective terminals of an OD switch 3 and spaced apart from each other. Each conductor 6 is formed with a stepped portion 6a such that the pair of rod-like conductors 6 extend downwardly along the outside guide surface 9a of the cylindrical hollow section of the skeleton frame 9. The skeleton frame 9 is integrally formed with a pair of conducting-line guides 9c at the lower end of its cylindrical hollow section. Each conducting-line guide 9c has a guide hole 9d and a cylindrical hollow portion 7, both intercommunicating with each other. The lower end of the conductor 6 is inserted into a guide hole 9d and partially exposed into the hollow portion 7.

Murakami fails to teach or suggest the combination of a switch adapter wherein the switch adapter comprises an adapter with an integrated switch therewith. The final rejection takes the position that the skeleton frame 9 is the equivalent of the switch adapter. Appellant respectfully disagrees with this interpretation of Murakami. The skeleton frame 9 cannot be considered the equivalent of the switch adapter of the present invention since the OD switch 3 is not integrated with the skeleton frame 9 as claimed. Murakami clearly discloses that the OD switch 3 is provided on one side of the shift knob 1. This is not a switch 3 that is integrated with the skeleton frame 9 as featured in the present invention. Further, the skeleton

frame 9 of Murakami does not have an outer surface that defines a recess for a connection cable as claimed. Murakami only discloses guide holes 9d, but the outer surface of the skeleton frame 9 does not define the guide holes 9d as claimed.

Murakami fails to teach and fails to suggest the combination of a hand knob connected to a switch adapter wherein the switch adapter is connected on an upper portion of a selector lever at a position above a shift gate as claimed. According to the present invention, the switch adapter has a recess wherein the connection cable is located within the recess of the switch adapter. The final rejection takes the position that the guide hole 9d of Murakami is the equivalent of the recess of the switch adapter as featured in the present invention. However, the guide hole 9d of Murakami is located below the elongated shift slot 26. This disadvantageously requires a more complicated electrical connection. Compared with Murakami, the switch adapter (adapter and integrated switch) of the present invention is located at a position above the shift gate. According to the present invention, a connection cable is provided wherein the connection cable is located in a recess in the switch adapter. This advantageously provides a prebuilt, prechecked switch adapter and the necessary electrical connection. This is significant in the present invention because the switch and necessary electrical connection are already connected to the upper portion of selector lever, which allows the shifting device to be quickly installed in a motor vehicle. This drastically reduces overall manufacturing costs. Murakami fails to disclose such reduced manufacturing cost advantages since Murakami clearly shows in Figure 1 that the skeleton frame 9 with the guide hole 9d is located at a position below the elongated shift slot 26. As such, the prior art as a whole takes

a completely different approach and fails to teach or suggest important features of the claimed combination.

Kim discloses a joystick controller 10 with interchangeable handles. The joystick controller 10 has a two-part housing 11 that includes a cover 20 and a bottom 30. A handle assembly 40, which includes handle member 60, is tiltably mounted in the housing 11. The cover 20 has a rectangular top wall 21 provided around the peripheral edges thereof with a continuous depending skirt or side wall 22. Integral with the top wall 21 centrally thereof and projecting upwardly therefrom is a frustoconical turret 23 having a circular aperture 24 in the upper end thereof. Mounted within the turret 23 is a handle support assembly 25, in which is mounted a flexible diaphragm 26. The diaphragm 26 has a central aperture therethrough in which is disposed a bushing 27. The bottom 30 of the housing 11 includes a rectangular bottom wall 31 integral at the perimeter thereof with a continuous upstanding skirt or side wall 32. The edges of the skirts 22 and 32 of the cover 20 and bottom 30, are flanged for mating engagement with each other for cooperation to form a closed housing. A plurality of leaf switches 36 are disposed within the housing 11 beneath the handle support assembly 25. The edge of the cover skirt 22 is provided with a notch for accommodating a cable 37. The handle assembly 40 includes an elongated, cylindrical, tubular shaft 41 that extends through the aperture 24 and has a reduced diameter inner end 42 extending through the bushing 27 coaxially therewith and secured thereto.

Kim fails to teach or suggest the combination of a switch adapter that is connected to an upper end of a selector lever at a position above a shift gate as claimed. At most, Kim

discloses a handle assembly 40 that includes a pivot lever 41. According to Kim, a push button is connected to a rod 50 that extends within the pivot lever 41. The push button 53 actuates the rod 50 to such that a switch 52 located in the two-part housing. The final rejection takes the position that the pivot lever 41 is the equivalent of the switch adapter of the present invention. Appellant disagrees with this interpretation since the push button 53 is not a switch as the push button 53 does not have any electrical features associated with a switch. Kim only discloses a switch 52 that is located within a two-part housing. However, the switch 52 is not integrated with the pivot lever 41 as claimed. Compared with Kim, the switch adapter of the present invention is connected to an upper portion of the selector lever at a position that is located above the shift gate. According to the present invention, the switch adapter has a recess wherein a connection cable is disposed. This advantageously decreases the time it takes to install the shifting device since the switch and the electrical lines do not have to be separately installed. This saves a significant amount of money in manufacturing costs since the labor involved in installing the shifting device in a motor vehicle is drastically reduced. Kim fails to disclose such manufacturing cost efficiency advantages since Kim does not disclose a switch adapter and in particular, a switch adapter that is located above a shift gate as claimed. As such, the prior art as a whole takes a completely different approach and fails to establish a *prima facie* case of obviousness since the prior art as a whole does not teach or suggest each and every feature of the claimed combination.

It is requested that the rejection of claim 15 be reversed.

CLAIM 17

Claim 17 presents the subject matter of claim 15 but further specifies that the connection cable has a line that transmits electrical and/or optical signals from the transmitting means to the support structure. The references as a whole fail to teach or suggest a switch adapter that is located at a position above a shift gate and clearly fails to suggest or teach this where the switch adapter includes a line that provides electrical and/or optical signal transmission to a support structure. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 17.

CLAIM 18

Claim 18 presents the subject matter of claim 15 but further provides that the switch adapter has at least one guide element for positioning the hand knob. The final rejection takes the position that the vertical rib portions disposed between guides 9c in Figure 6 of Murakami are the equivalent of the at least one guide element of the present invention. However, Murakami does not provide any teaching or suggestion that the vertical rib portions disposed between guides 9c are used for positioning the shift knob 1 as claimed. As such, the prior art as a whole does not establish a *prima facie* case of obviousness as the prior art as a whole does not teach or suggest each and every feature of the claimed combination. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 18.

CLAIM 19

Murakami and Kim fail to teach or suggest a hand knob that surrounds a switch adapter with the switch adapter having an outer surface that defines a recess wherein the switch adapter is located at a position above the shift gate. Murakami merely discloses a shift knob 1 and a skeleton frame 9 that pass through a shift slot 26. However, the skeleton frame 9 of Murakami is not the equivalent of the switch adapter of the present invention since the skeleton frame 9 does not have a switch integrated therewith. Further, the guide holes 9d of Murakami are not defined by an outer surface of the skeleton frame 9 as claimed. Kim also fails to provide any teaching or suggestion for a switch adapter that is located at a position above a shift gate wherein the hand knob surrounds the switch adapter as claimed. A person of ordinary skill in the art would not be directed to the teachings of Kim in view of the disclosure of Murakami since Kim fails to be concerned with providing a shifting device in a motor vehicle as featured in Murakami. Kim is merely concerned with the problem of providing interchangeable handle assemblies for a joystick. Even if a person of ordinary skill in the art was directed to the teachings of Kim, Kim does not teach or suggest the combination of a switch adapter that is located above a shift gate as claimed. Kim clearly discloses a push button 53 that actuates a rod 50 that extends within a pivot lever 41 such that the rod 50 actuates a switch 52. The switch 52 of Kim is not integrated with the pivot lever 41. As such, the prior art as a whole takes a completely different approach and fails to establish a prima facie case of obviousness. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 19.

CLAIM 20

The final rejection takes the position that the top surface of push button 53 of Kim is the equivalent of the switch display part of the present invention. However, a fair reading of the Kim reference discloses that there is no switch display part as featured in the present invention. Kim only teaches a push button 53, but there is no teaching or suggestion of the push button 53 of Kim having any type of display part as claimed. In fact, there is not teaching or suggestion in Kim for a switch display part that is located opposite the push button 53 as claimed. Compared with Kim, the adapter of the present invention has a switch display part that is located opposite the switch. This allows the display part to visually indicate to a driver the particular state of the transmission, such as whether the transmission is in drive or neutral. In contrast to the present invention, Kim only discloses a push button 53, but does not teach or suggest that a switch display part is located opposite the push button 53 as featured in the present invention. As such, the prior art as a whole does not establish a *prima facie* case of obviousness as the prior art as a whole does not teach or suggest each and every feature of the claimed combination. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 20.

Conclusion

The invention as claimed presents a combination of features which is neither taught nor suggested by the prior art. The rejection does not present a *prima facie* case of obviousness. The claimed invention should be considered patentable and nonobvious. Accordingly, it is

requested that the rejections based on prior art be reversed.

ISSUE: Whether claim 21 is rejectable under 35 U.S.C. 103(a) as being unpatentable over Murakami in view of Kim.

Claim 21 is directed to an adapter that has an switch integrated therewith (hereinafter "switch adapter"). The switch adapter is mounted to an upper end of a selector lever wherein the adapter is located at a position above a shift gate. A hand knob is connected to the upper end of the selector lever such that the hand knob is arranged on the switch adapter. The switch adapter has an outer side surface that defines a recess. One or more lines of a connection cable are located within the recess. The one or more lines are connected to a switch interface of the integrated switch. This arrangement advantageously allows the shift gate to be passed over the selector lever and the switch adapter. The arrangement of the switch adapter with the one or more lines located within the recess provides a quick and simple electrical and/or optical connection of the switch adapter to the housing structure. The claimed arrangement does not require any complicated electrical connections as featured in conventional techniques. This saves significantly on manufacturing costs since installation of the shifting device in a motor vehicle is simplified. Further, the recess in the adapter provides particular electrical connection protection features, which saves significantly on packaging costs of the shifting device.

The final rejection takes the position that it would be an obvious design choice to provide a switch adapter with an electrical and/or optical connection at a position above a shift gate. Appellant respectfully disagrees with this interpretation as Murakami and Kim do not

provide any teaching or suggestion for a switch adapter having an electrical and/or optical connection wherein the switch adapter with the electrical and/or optical connection is located at a position above a shift gate. Further, there is no teaching of a switch adapter as claimed. The references must be given a fair reading for what they teach and suggest. Murakami merely discloses a skeleton frame 9 that has guide holes 9d wherein the guide holes 9d are located below a shift gate. The skeleton frame 9 does not have a switch integrated therewith. Murakami clearly discloses in Figure 2 that the OD switch 3 is provided on one side of the shift knob 1 and is not integrated with the skeleton frame 9 as claimed. The skeleton frame 9 of Murakami cannot be the equivalent of the switch adapter of the present invention since the skeleton frame 9 does not have a switch integrated therewith and the skeleton frame 9 does not have a recess defined by an outer surface of the skeleton frame 9 as claimed. Even assuming that the skeleton frame 9 of Murakami is somehow the equivalent of the switch adapter of the present invention (which Appellant maintains it is not), there is no teaching or suggestion in Murakami for providing the skeleton frame 9 with guide 9d above a shift gate as featured in the present invention. There is no mention of the guide holes 9d of Murakami being located above a shift gate as claimed. As such, the prior art as a whole does not establish a *prima facie* case of obviousness.

Kim also does not teach or suggest critical aspects of the invention. The final rejection relies on Kim to teach that it is well known in the art to provide a switch adapter above a shift gate. However, Kim does not teach a switch adapter and does not teach a shift gate. Kim teaches away from the present invention as Kim does not teach or suggest the critical aspect

of a switch adapter having an electrical and/or optical connection for connecting the switch adapter to a housing structure wherein the switch adapter with the electrical and/or optical connection is located at a position above a shift gate. Kim discloses nothing more than a common joystick. According to Kim, a push button 53 is connected to a rod 50 that extends within a pivot lever 41 wherein the push button 53 is actuated such that the rod 50 contacts a switch that is located within a two-part housing. The final rejection takes the position that the pivot lever 41 is the equivalent of the switch adapter of the present invention. Appellant respectfully disagrees with this interpretation of Kim since the push button 53 is not a switch as featured in the present invention as the push button 53 does not have any electrical features. Kim clearly discloses that only a switch 52 is provided in a two-part housing. The pivot lever 41 cannot be considered the equivalent of the switch adapter of the present invention since the switch 52 is not integrated with the pivot lever 41 as claimed. This provides no teaching and no suggestion for providing a switch adapter adapter at a position above a shift gate as claimed.

Kim fails to provide any teaching or suggestion that would direct a person of ordinary skill in the art toward a hand knob that surrounds a switch adapter wherein the hand knob and the switch adapter are located at a position above a shift gate as claimed. Kim merely discloses a handle assembly that surrounds a portion of a pivot lever 41 wherein the pivot lever 41 and a rod 50 extends into an interior of a two-part housing. According to Kim, the rod 50 contacts a switch 52 located within the two-part housing when the push button 53 is actuated. This does not direct a person of ordinary skill in the art toward providing a switch adapter above a shift gate since Kim clearly teaches that the pivot shaft 41 is not integrated with the switch 52 and

the switch 52 is located within the two-part housing. In fact, the references as a whole do not provide any suggestion of using the teachings of Kim to modify the device of Murakami. As such, the prior art as a whole does not establish a *prima facie* case of obviousness as the prior art as a whole does not teach or suggest each and every feature of the claimed combination. Accordingly, it is requested that the Examiner's rejection be reversed with respect to claim 21.

Conclusion

The invention as claimed presents a combination of features which is neither taught nor suggested by the prior art. The rejection does not present a *prima facie* case of obviousness. The claimed invention should be considered patentable and nonobvious. Accordingly, it is requested that the rejections based on prior art be reversed.

Respectfully submitted
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SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE
IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 13-
0410.

(8) CLAIMS APPENDIX

1. A shifting device for transmitting shift commands to a motor vehicle transmission,
the shifting device comprising:

5 a housing support structure;
 a selector lever for transmitting shift commands to the motor vehicle transmission, said
 selector lever having an upper portion;
 a hand knob forming a gripping surface for engagement by a hand of a driver of the
 motor vehicle;

10 a connection cable comprising one or more lines for transmitting electrical and/or
 optical signals;

 a switch; and
 an adapter mounted on said upper portion of said selector lever, said adapter having
 said switch integrated therewith, said adapter having an outer surface, said outer surface
 defining a recess, wherein at least a portion of said one or more lines extends within said
 recess, said adapter defining a connection between said selector lever and said hand knob, the
 shifting device being provided for installation in a motor vehicle, wherein a shifting gate is
15 pushed over said selector lever, said adapter being located at a position above the shift gate,
 said hand knob being connected to said upper portion of said selector lever via said adapter.

2. A shifting device in accordance with claim 1, wherein said switch integrated in said
adapter includes means for transmitting electrical and/or optical signals.

3. A shifting device in accordance with claim 1, wherein said adapter has a switch interface for a connection cable.

4. A shifting device in accordance with claim 1, wherein said at least said portion of said one or more lines being located adjacent to said exterior surface of said adapter, said hand knob surrounding said adapter, said adapter having a top outer surface, said top outer surface defining a switch recess, said switch being located in said switch recess, said adapter and said hand knob being located at a spaced location from said shift gate, said shift gate being located at a position below said hand knob.

5. A shifting device in accordance with claim 1, wherein said adapter has a switch display part.

6. A shifting device in accordance with claim 4, further comprising a switch display part, said switch display part being arranged opposite said switch.

7. A shifting device in accordance with claim 1, wherein said adapter has at least one guide element for positioning said hand knob.

8. A shifting device in accordance with claim 1, wherein said adapter has a boring, into which said selector lever can be at least partially inserted.

9. A shifting device in accordance with claim 1, wherein said adapter is fastened to said selector lever via a screw connection.

10. A shifting device in accordance with claim 1, wherein said adapter is fastened to said selector lever via a clip connection.

11. A shifting device in accordance with claim 1, wherein said adapter has a plastic molding, which is injection-molded on the selector lever via an injection molding process.

12. A shifting device in accordance with claim 1, wherein said adapter has an actuator button part connected to said switch.

13. A shifting device in accordance with claim 12, wherein said hand knob has an opening for access to said actuator button part.

14. A shifting device in accordance with claim 13, wherein said actuator button part also comprises a switch display part.

15. A shifting device for transmitting shift commands to a motor vehicle transmission, the shifting device comprising:

a support structure;

5 a selector lever comprising an upper selector lever portion and a lower selector lever portion, said lower selector lever portion being connected to said support structure, said selector lever for transmitting shift commands to the motor vehicle transmission;

a connection cable;

10 an adapter mounted to said upper selector lever portion of said selector lever, said adapter having an integrated switch, said integrated switch including a switch interface for said connection cable and a means for transmitting electrical and/or optical signals, said adapter having an adapter outer side surface, said adapter outer side surface defining a recess, said connection cable being located within said recess, wherein said connection cable is located adjacent to said outer surface of said adapter;

15 a hand knob forming a gripping surface for engagement by a hand of a driver of the motor vehicle driver, said adapter defining a connection between said upper selector lever portion of said selector lever and said hand knob, said adapter being connected to said hand knob, the shifting device being provided for installation in a motor vehicle, wherein the diameter of the selector lever and the adapter is smaller than a shift gap defined by side edges of a shift gate whereby the shift gate is passed over said selector lever and said adapter, 20 wherein said adapter is located a position above the shift gate.

17. A shifting device in accordance with claim 15, wherein said connection cable has a line, said line transmitting said electrical and/or optical signals from said transmitting means to said support structure.

18. A shifting device in accordance claim 15, wherein said adapter has at least one guide element for positioning said hand knob.

19. A shifting device in accordance with claim 15, wherein said adapter has a part with at least one of an actuator button part and a switch display part connected to said switch, said adapter having a top outer surface, said top outer surface defining an integrated switch recess, said integrated switch being arranged in said integrated switch recess, said hand knob surrounding said adapter.

20. A shifting device in accordance with claim 19, wherein said hand knob has an opening for access to said at least one of an actuator button part and a switch display part connected to said switch, said switch display part being disposed opposite said integrated switch.

21. A shifting device for transmitting shift commands to a motor vehicle transmission, the shifting device comprising:

a support structure;
a selector lever having an upper end and a lower end, said lower end being connected to said support structure, said selector lever for transmitting shift commands to the motor vehicle transmission;

a connection cable having one or more lines;

an adapter mounted to said upper end of said selector lever, said adapter having a top outer surface, said top outer surface defining an integrated switch recess, said adapter having an integrated switch arranged in said integrated switch recess, said integrated switch including a switch interface, said adapter having an adapter outer side surface, said adapter outer side surface defining a recess, said one or more lines being located within said recess, said one or more lines being located adjacent to said adapter outer side surface, said one or more lines being connected to said switch interface;

15 a hand knob forming a gripping surface for engagement by a hand of a driver of the motor vehicle driver, said hand knob surrounding said adapter, said adapter defining a connection between said upper end of said selector lever and said hand knob, whereby said hand knob is connected to said upper end of said selector lever via said adapter, the shifting device being provided for installation in a motor vehicle, wherein the diameter of the selector lever and the adapter is smaller than a shift gap defined by side edges of a shift gate whereby the shift gate is passed over said selector lever and said adapter, said hand knob being arranged on said adapter, said shift gate being located at a position below said adapter.

(9) Evidence appendix

NONE

(10) Related proceedings appendix

NONE